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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,255	06/26/2003	Dominique Charmot	2003-042	7767
22905	7590	09/14/2004	EXAMINER	
SYMYX TECHNOLOGIES INC LEGAL DEPARTMENT 3100 CENTRAL EXPRESS SANTA CLARA, CA 95051				ASINOVSKY, OLGA
		ART UNIT		PAPER NUMBER
		1711		

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/609,255	CHARMOT ET AL.
	<b>Examiner</b> Olga Asinovsky	<b>Art Unit</b> 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 June 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/407,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-36 of application No. 10/407,405 disclose a method of free radical polymerization comprising (1) forming a mixture of monomer(s), a free radical initiator and a control agent=chain transfer agent comprising a thio group, (2) subjecting said mixture of polymerization condition, wherein a resulting polymer comprises thio groups, (3) contacting the resulting polymer with a free radical source under cleavage reaction condition, and (4) activating the free radical source to generate radicals, wherein at least 50% of the thio groups are replaced with a group of interest other than hydrogen.

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3. The difference is that claims of application No. 10/407,405 does not disclose in step (3) of an addition monomer having a propagation rate constant (K<sub>p</sub>) less than 2000. It would have been obvious to one of ordinary skill in the art to consider that any addition monomer(s) could be present, because the claims 1-36 of Application No. 10/407,405 discloses a controlled method in the step (3) for a continuous polymerization process wherein any additional polymerizable monomer(s) is/are expected, since claims 3 and 34 of application No. 10/407,405 disclose in step (3) a presence of a compound having a general formula CR<sub>1</sub>R<sub>2</sub>=CXY such that a said compound is readable as a monomer in the step (3) in the present claims. The prima facie case of obviousness is that a monomer compound having the general formula CR<sub>1</sub>R<sub>2</sub>=CXY in claims 1-36 of Application No. 10/407,405 is readable as being a monomer in a step (3) in the present claims and wherein a said polymerizable compound can have a propagation rate constant (K<sub>p</sub>) less than 2000, since reference's claims discloses a controlled "living" continuous polymerization process..

4. Also, claims 1-36 of Application No. do not disclose a block copolymer for the present claim 15 or a random copolymer for the present claim 16. It would have been obvious to one of ordinary skill in the art to consider that a method of producing a block copolymer in the present claim 15 or a random copolymer in the present claim 16 can be obtained in a method in claims 1-36 of Application No. 10/407,405 because claims 1-36 of Application No. 10/407,405 disclose a continuous polymerization process under the controlled process conditions wherein the desired structure such as a block copolymer of a random copolymer can be obtained.

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5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

There are no references with PRO Form 1449.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

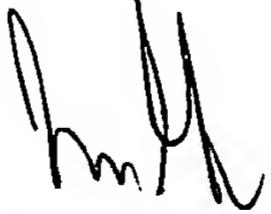
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Olga Asinovsky  
Examiner  
Art Unit 1711



O.A.  
September 10, 2004



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700